

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1-268.

The following claims are *independent*: 1, 58, 116, 173, 230, 236, 242, 248, 254.

Please *amend* claims 1, 58, 116, 173, 230, 236, 242, 248, 254; although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices (hereinafter “amendment,” “amendments,” and/or “amended”), Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 101

The Office Action has rejected claims 1-57 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. Applicant submits that there is no test for non-statutory subject matter that subjectively precludes the aforementioned claims. MPEP § 2106, Section IV, states “claims directed to nothing more than abstract ideas (such as mathematical algorithms), natural phenomena, and laws of

nature are not eligible for patent protection.” MPEP § 2106 also discusses “[w]hile abstract ideas, natural phenomena, and laws of nature are not eligible for patenting, methods and products employing abstract ideas, natural phenomena, and laws of nature to perform a real-world function may well be.” Applicant submits that the elements recited in the claims are, in fact, directed to statutory subject matter and do not fall within the recognized Judicial Exceptions as merely abstract ideas (such as mathematical algorithms), natural phenomena, and/or laws of nature.

Although Applicant respectfully traverses the Examiner’s rejection and reserves the right to argue patentability of the claims in their original form at a later time, Applicant has amended independent claim 1. Claim 1 recites, *inter alia*, “A creative work evaluating processor-implemented method ... providing via a processor ... pairing via the processor ... totaling via the processor.” As such, Applicant submits claim 1 (and as a consequence, claims depending therefrom) are transformative and/or specific structures directed to statutory subject matter for at least the reasons discussed above.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific explanation describing how claims 1-57 are allegedly directed to non-statutory subject matter. Accordingly, Applicant submits that claims 1-57 are directed to statutory subject matter, and respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-10, 12, 14-16, 19-27, 29-35, 39-41, 44-47, 58-67, 69, 71-73, 76-84, 86-93, 97-99, 102-105, 116-125, 127, 129-131, 134-142, 144-150, 154-156, 159-162, 173-182, 184, 186-188, 191-199, 201-207, 211-213, 217-219, 254-258, 260-268 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Paul, US Patent Application No. 2003/0171982 (hereinafter "Paul"), in view of Jokipii et al, US PG Publication No. 2003/0190960 (hereinafter "Jokipii"). The Office Action rejected claims 11, 13, 17-18, 28, 36-38, 42-43, 48-54, 68, 70, 74-75, 85, 94-96, 100-101, 106-112, 126, 128, 132-133, 143, 151-153, 157-158, 163-169, 183, 185, 189-190, 200, 208-210, 214-215, 220-226, 259 under 35 U.S.C. § 103(a), allegedly, as being unpatentable over Paul, in view of Jokipii, and in further view of Foroutan, US Patent No. 7,162,433 (hereinafter "Foroutan"). The Office Action rejected claims 55-57, 113-115, 170-172, 227-229 under 35 U.S.C. § 103(a) as being unpatentable over Paul, in view of Jokipii, in view of Foroutan, and in further view of Von Kohorn, US Patent No. 5,916,024 (hereinafter "Von Kohorn"). The Office Action rejected claims 230-233, 236-239, 242-245, 248-251 under 35 U.S.C. § 103(a) as being unpatentable over Jokipii, in view of Foroutan. The Office Action rejected claims 234-235, 240-241, 246-247, 252-253 under 35 U.S.C. § 103(a) as being unpatentable over Jokipii, in view of Foroutan, and in further view of Paul.

Requirements to Establish Prima Facie Obviousness

The Supreme Court in *Graham v. John Deere Co. of Kansas City* prescribed that a *prima facie* showing of obviousness under 35 U.S.C. § 103 requires that, "the obviousness or

nonobviousness of the subject matter [be] determined," and details further requirements, commonly referred to as "Graham factors," which include that "[1] the scope and content of the prior art [be] determined, [2] differences between the prior art and the claims at issue [be] ascertained, and [3] the level of ordinary skill in the pertinent art [be] resolved." *Graham*, 383 U.S. at 1, 17 (1966). To comply with the Graham factors, as introduced in *Graham* and reaffirmed in *KSR Intern. Co. v. Teleflex Inc.*¹, MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate;
- (B) the difference or differences in the claim over the applied reference(s);
- (C) the proposed modification of the applied reference(s) to arrive at the claimed subject matter; and
- (D) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

The MPEP prescribes that, "when evaluating the scope of a claim, *every limitation in the claim must be considered*," (§ 2106 II(C), emphasis added) and, "*All words* in a claim must be considered in judging the patentability of that claim against the prior art." (§ 2143.03, emphasis added). Applicant submits that the pending rejection has failed to consider "every limitation in the claim" and "[a]ll words in [the] claim" in judging the patentability of the claim against the prior art by mischaracterizing claim elements and/or

¹ The "[Graham] factors continue to define the inquiry." 550 U.S. 398 (2007).

over-generalizing the applied reference(s). As with this Office Action, when the Examiner mischaracterizes and/or provides references that are missing claimed elements, then the Examiner has failed to fulfill MPEP § 706.02(j) requirements **(A)** and/or **(D)**, and as a consequence, has failed to establish a *prima facie* case of obviousness. 35 U.S.C. § 103.

Missing Claim Element(s)

Applicant submits the cited references (taken alone or in combination) do **not** discuss, do **not** render obvious, and are in fact missing at least the following element(s) as recited, *inter alia*, in previously presented independent claim 1:

A creative work evaluating processor-implemented method,
comprising:

...

providing an offer to compete, wherein the offer to compete
includes parameters that specify a potential competitor and
competition rules;

...

The Office Action asserts the above claimed elements are shown in Jokipii (paragraphs 35, 46, 50-51). The Examiner admits that:

Paul does not explicitly disclose wherein the offer to compete
includes parameters that specify a potential competitor and
competition rules; (Office Action, p. 6).

However, the Examiner attempts to remedy this deficiency in Paul by relying on Jokipii and alleging that:

Jokipii discloses this limitation (see paragraph 35 ... paragraph 46
... paragraphs 50-51 ...); (Office Action, p. 6).

Applicant disagrees and submits the Office Action mischaracterized Jokipii and hereby traverses.

Contrary to the Office Action's assertions, Applicant submits that Jokipii essentially discusses an *online gaming system having open tables with unspecified participants* instead of the previously claimed "providing an offer to compete, wherein the offer to compete includes parameters that specify a potential competitor and competition rules," much less of the currently claimed:

providing via a processor an offer to compete by a first user,
wherein the offer to compete includes parameters that specify a
second user as a potential competitor and competition rules;

as recited in amended claim 1. In Jokipii, "the game room interface ... enable[s] a user to create his/her own table or to initiate play," (Jokipii, paragraph [0046]). The user creating a table is unable to specify a potential competitor. If the user wants to initiate play, "a game table information window 720 lists current game tables so that [unspecified] users can determine whether there are any game tables that they can join," (Jokipii, paragraph [0046]). Accordingly, Applicant submits that Jokipii's *online gaming system having open tables with unspecified participants*, is different from at least the claimed "providing via a processor an offer to compete by a first user, wherein the offer to compete includes parameters that specify a second user as a potential competitor and competition rules," as recited in amended claim 1.

Should the Examiner maintain the rejection, Applicant respectfully requests that the Examiner provide specific citations and explanations describing how each and every element of the pending claims are allegedly rendered obvious by the cited reference, providing

indications of specific, alleged correspondences between claim elements and cited portions of the applied reference.

Although of different scope than independent claim 1, Applicant submits claims 58, 116, 173, 254 (and as a consequence any claims depending therefrom) are all patentable over the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Jokipii with regard to independent claim 1. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Furthermore, amended claim 254 recites, *inter alia*, "pair a plurality of competitors based on the acceptance to the offer according to parameters specified in the competition offer fields." Accordingly, Applicant submits competition offer fields should be given patentable weight.

Similarly, Applicant submits that Foroutan's *system that allows producers to submit content for ranking* fails to remedy the deficiencies identified above in Jokipii with regard to independent claim 230. For at least the reasons discussed above, Applicant submits that the pending rejection has mischaracterized the language of the claim element(s) and/or the applied reference(s) and, thus, has not established a *prima facie* case of obviousness. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Although of different scope than independent claim 230, Applicant submits claims 236, 242, 248 (and as a consequence any claims depending therefrom) are all patentable over

the cited references (taken alone or in combination) for at least similar reasons as discussed above when identifying deficiencies in the Office Action's application of Jokipii with regard to independent claim 230. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and allowance of claim(s).

Objective Rationale for Modifying the References

Applicant has argued that the applied references fail to discuss or render obvious every element of the pending claims, and that the Examiner has not carried his burden to establish factors **(A)** and **(B)** of MPEP § 706.02(j) in the pending rejection. However, even if, *arguendo*, the applied references did show every element of the pending claims, Applicant submits that the Examiner has not faithfully analyzed factors **(C)** and **(D)** of MPEP § 706.02(j), which requires that the Office Action set forth “the proposed modification of the applied reference(s) to arrive at the claimed subject matter” and “an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.”

MPEP 2143.01 (V) prescribes that “the proposed modification cannot render the prior art unsatisfactory for its intended purpose,” and, “[i]f the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification.” Applicant notes that the pending rejection alleges:

It would have been obvious to one of ordinary skill in the art at the time the invention was made to include Jokipii's functionality of

allowing competitors to specify a potential competitor and game rules when carrying out Paul's competition; (Office Action, p. 6).

Applicant respectfully traverses this argument and suggests that Paul teaches away from the proposed modification, including a combination with Jokipii, and that the proposed modifications of the applied references renders them unsuitable for their stated purposes. Paul's bracketed competition system, does not allow a user to choose a potential competitor. By way of example only, Applicant draws the Examiner's attention to paragraph [0017] of Paul, which recites:

Following every two contestants, those observing the rap will vote upon the preferred competitor. The winner of each two person competition will have opportunity to compete against another competitor... Eventually, one competitor will be the winner of a stage; (Paul, paragraph [0017]).

Applicant submits that modifying Paul's bracketed competition system with "Jokipii's functionality of allowing competitors to specify a potential competitor," as proposed in the pending rejection, comprises a clear teaching away from Paul and would render Paul unsuitable for its intended purpose. The sole purpose of a bracketed system is to provide no user choice in selecting an adversary, rather, the system makes the bracketed pairings. Allowing competitors to choose adversaries in a bracketed system is akin to allowing an NCAA basketball team to choose an opposing team during a championship tournament, which is antithetical to the concept of a tournament. Applicant therefore submits that the pending rejection has applied impermissible hindsight and that a *prima facie* showing of obviousness has not been made. Accordingly, Applicant respectfully requests reconsideration and withdrawal of this

basis of rejection. Should the Examiner maintain the rejection, Applicant respectfully requests clarification as to how the Examiner believes the proposed modifications of the references allegedly fail to render the references unsuitable for their stated purposes.

CONCLUSION

Applicant asserts that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art to this Office Action (and/or any previous office action(s)) (hereinafter "Office Action(s)"). While many other claim elements and/or bases for rejection were not discussed, as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art, and Applicant reserves the opportunity to more particularly traverse, remark and/or distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to the Office Action(s)' objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to other Office Action(s) objection(s) and/or rejection(s) as to any other claim element(s), any such re-assertion(s) of remarks are not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim element(s), and no such commonality is admitted as a consequence of any such re-assertion(s) of remarks. Consequently, the reference(s) cited the Office Action(s) do not result

in the claimed invention(s), there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed invention(s) are not admitted to be prior art. Also, Applicant does not accept, admit, and/or concede to any assertions, (mis)characterizations (e.g., of claims, references, and/or otherwise), and/or Official Notice(s) in the Office Action(s). As such, Applicant does not concede that any claim element(s) have been anticipated and/or rendered obvious by any of the cited reference(s) and/or any Official Notice in the Office Action(s). Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1-268, all: overcome all rejections and/or objections as noted in the Office Action(s), are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 19778-002. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby

authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 19778-002.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
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